

## REMARKS

Claims 1-3 are pending in the application.

Claims 1-3 rejected under 35 U.S.C. 112, second paragraph and under 35 U.S.C. 102(b) as being clearly anticipated by *Nongyaoxue Xuebao* (1999), 1(3), p. 8-13.

Claims 1 and 3 are amended.

US 4,670,373 describes photographic material comprising oximester compounds. The generic description covers aldoxime compounds. Several compounds according to the definition of the Applicants' present claim 1 are disclosed specifically. See columns 4, 6, 7 and 8 of US '373, compounds numbered (10), (23), (28), (30), (33), (41), and (42). The disclaimers (x) and (vii) in the Applicants claim 1 are expanded to exclude compounds (10), (23), (28), (30), (33) and (42) and disclaimer (ia) is inserted to exclude compound (41) of US '373. Applicants aver that there is no anticipation by US '373.

### Information Disclosure Statement

The Examiner states for the record that the file does not contain a supplemental IDS filed by Applicants on or about 8/12/02. The Applicants are resubmitting the IDS with abstracts of the cited references and fee letter set forth in 37CFR 1.17(p) filed on 8/12/02.

The Examiner is kindly requested to indicate that the references have been considered by returning an initialed copy of PTO form 1449.

### 35 U.S.C. §112 Second Paragraph

Claim 1-3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner points out that the substituent definitions such as R<sub>4</sub> are not defined. The Applicants have amended the claims to include the missing definitions according to the original claims 1 and 3 and further supported by definitions on pages 6-8 of the specifications. The definitions for R<sub>3</sub>, R<sub>3</sub>, R'<sub>3</sub>, R<sub>4</sub>, R<sub>5</sub>, R<sub>6</sub>, R<sub>7</sub> and R<sub>8</sub>, n, and r are now defined. Thus the 35 U.S.C. §112 second paragraph

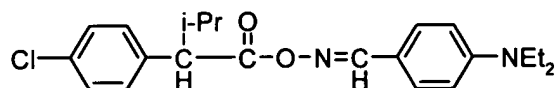
rejection is overcome.

No new matter has been added.

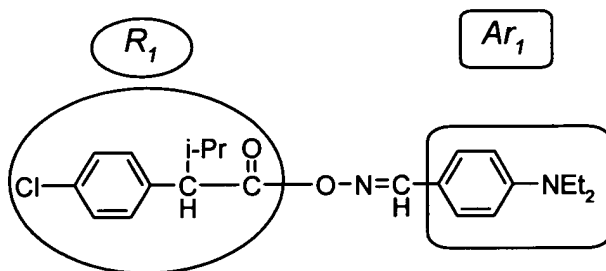
**35 U.S.C. § 102(b)**

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by *Nongyaoxue Xuebao* (1999), 1(3), p. 8-13.

The Examiner alleges, that the compounds as claimed where  $Ar_1 = -C_6H_5NR_5R_6$  and  $C_6H_3OR_3R_3$  are anticipated by similar compounds found in *Nongyaoxue Xuebao* (1999), 1(3), p. 8-13, such as that registered in Chemical Abstract as No. 349450-96-0 below.



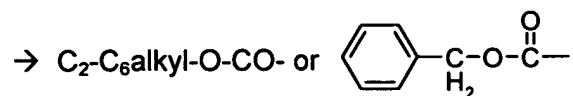
The Applicants disagree. Compounds like this are NOT covered by the definitions of the present claims:



The definition of  $R_1$  in the present claims does not encompass the encircled group:

$R_1$  is

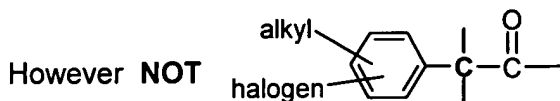
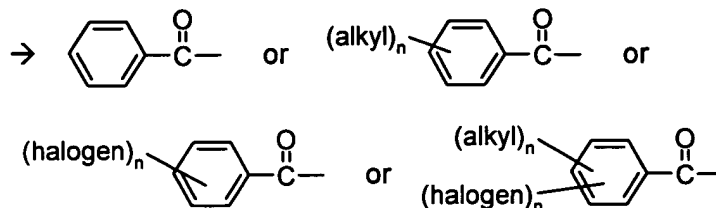
—  $C_2$ - $C_6$ alkoxycarbonyl or benzyloxycarbonyl;



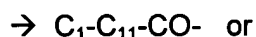
— C<sub>4</sub>-C<sub>6</sub>alkenoyl, provided that the double bond is not conjugated with the carbonyl group;



— benzoyl which is unsubstituted or substituted by one or more C<sub>1</sub>-C<sub>6</sub>alkyl or halogen;



— C<sub>1</sub>-C<sub>12</sub>alkanoyl which is unsubstituted or substituted by one or more halogen or phenyl;



However **NOT** C<sub>1</sub>-C<sub>11</sub>-CO-, substituted by phenyl, which is substituted by halogen... The defined substituent refers to the alkanoyl group, not to the phenyl group.

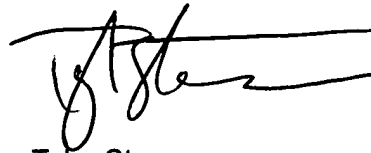
The above explanations make clear, that a group as given in the cited formula is not the subject of the present claims 1-3. Thus there is no anticipation by *Nongyaoxue Xuebao* (1999), 1(3), p. 8-13 and the rejection is overcome.

Reconsideration and withdrawal of the rejection of claims 1-3 is respectfully solicited in light of the amendments and remarks *supra*.

Since there are no other grounds of objection or rejection, passage of this application to issue with claims 1-3 is earnestly solicited.

Applicants submit that the present application is in condition for allowance. In the event that minor amendments will further prosecution, Applicants request that the examiner contact the undersigned representative.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Tyler Stevenson', written over a horizontal line.

Tyler Stevenson  
Agent for Applicants  
Reg. No. 46,388

Ciba Specialty Chemicals Corporation  
540 White Plains Road  
Tarrytown, New York 10591  
(914) 785-2783  
SAL22140\_OA.doc

Enclosures: Petition for 2 month extension

Form PTO-1449

Fee Letter for IDS

Four abstracts cited in PTO-1449